

REMARKS

This application has been reviewed in light of the Office Action dated October 14, 2009. Claims 1, 3–7, 9, 11–13, and 15–20 are pending in the application. Claims 8 and 14 have been cancelled without prejudice in the present amendment, and their subject matter has been added to claims 1, 11, and 20. Claims 1, 11, 15, and 20 have been amended. No new search is required to respond to this amendment. The amendment should be considered because the issuance of a final office action was improper, as discussed below. No new matter has been added. The Examiner's reconsideration of the rejection in view of the following remarks is respectfully requested.

Preliminarily, Applicants object to the Examiner's issuance of a final office action. MPEP § 706.07(a) states, "Under present practice, second or any subsequent actions on the merits shall be final, **except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims**, nor based on information submitted in an information disclosure statement..." In the Office Action of April 17, 2009, the Examiner did not reject claim 10. Applicants reasonably believed therefore that claim 10 was patentable over the then-cited art. In other words, the Examiner implicitly found that claim 10 included patentable *subject matter*, even if there were other standing rejections under section 112.

In response, the Examiner has cited completely new art. MPEP § 706.07(a) states, "[A] second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings **will not be made final if it includes a rejection, on newly cited art**, ... of any claim not amended by applicant or patent owner in spite of the fact that other claims

may have been amended to require newly cited art.” The claim language added to claim 1 contains, verbatim, the language of claim 10. Therefore, the Examiner has issued a new rejection against subject matter that has not been amended.

In addition, the Examiner has put forth *several* new grounds for rejection under section 112, which Applicants have not had any previous opportunity to address. In the interest of fairness and of expediting prosecution, it is respectfully requested that the Examiner withdraw the finality of the present rejection and consider the present amendments so that Applicants may have a fair opportunity to respond to the new grounds for rejection.

Claim 1 has been objected to. The Examiner notes that the claim recites, “a first wireless access,” but that there is no “second wireless access” recited. The claim has therefore been amended to recite “a wireless access.” Although the preamble to the claim recites “a wireless access,” Applicants have declined to amend the body of the claim to “*the* wireless access.” It is believed that the claim language as amended is suitably clear.

Claims 1, 3–7, 9, 11–13, and 15–18 stand rejected under 35 U.S.C. § 101 as lacking utility.

In particular, the Examiner asserts that the present claims are “just data manipulation.” The Examiner relies on the “useful, concrete, and tangible” test from the CAFC’s decision in *State Street*. 149 F.3d 1373–74. However, the applicability of this test was explicitly abridged in the more recent *Bilski* decision, wherein the CAFC stated, “Therefore, we also conclude that the ‘useful, concrete and tangible result’ inquiry is inadequate and reaffirm that the machine-or-transformation test outlined by the Supreme Court is the proper test to apply.” 545 F.3d 943 (2008). The CAFC determined that a “machine-or-transformation” test was more appropriate for

determining the subject matter eligibility of method claims, a test which the present claims certainly pass.

However, with respect to the Examiner's more fundamental assertion—that the present invention lacks “real world” value—it should be noted that the present specification states on page 3, lines 20–22, “The present invention ... provides users with the ability to develop their character over time as they play with, e.g., other users at different hotspots.” This is a direct and clear statement of a specific and substantial utility. MPEP § 2107.01(I) generally states, “Office personnel should focus on and be receptive to assertions made by the applicant that an invention is ‘useful’ for a particular reason.”

The ability to maintain a character between various hotspots provides “a well defined and particular benefit to the public,” as required in MPEP § 2107.01(I)(A). That ability is furthermore useful to the public “in its current form,” as required by MPEP § 2107.01(I)(B). Therefore, it is respectfully asserted that claims 1, 3–9, and 11–18 are directed to *useful* subject matter. Reconsideration of the rejection is earnestly solicited.

Claims 1, 3–7, 9, 11–13, and 15–20 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement.

In particular, the Examiner asserts that claims 1 and 11 lack enablement with respect to how a wireless channel can convey an unsaved character in a transportable medium in order to load them into a server. The Examiner presumably has interpreted “providing the ability to transport” to include the previously recited wireless access.

In truth, however, the claims do not in any way recite the use of a wireless channel in this transportation. Instead, note that claim 1 first recites, “saving the selected savable character onto

the transportable storage medium.” Only thereafter is the savable character transported from the first gaming server to a second gaming server. It is evident that the transportable storage medium may be used to provide the ability to transport the character. As such, a description of how one might use a wireless channel is entirely unnecessary to enable the use of the present invention. It is therefore respectfully asserted that providing the ability to transport a savable character is enabled by the present specification.

The Examiner also states, “If the memory does not have data how can it loads into the game.” The meaning of this statement is unclear. As noted above, the claim explicitly recites saving the savable character to the transportable storage medium. As such, by the time the method gets to providing the ability to transport the character, the character has already been saved to the storage medium. It is clear then that the memory *does* have data, and can naturally be used to load the character data into a game.

The Examiner further rejects claims 1, 3–7, 9, 11–13, and 15–19 under similar reasoning. The Examiner states that the specification “does not reasonably provide enablement for accessing the first game server via wireless and another game server via wire-line. The claims do not recite the use of a wired game server, but the Examiner presumably has interpreted the term “a second gaming server” as including such a possibility.

However, the written description of an invention need not provide enablement for each and every conceivable embodiment. MPEP § 2164.01 states, “Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention.”

Thus, as long as the disclosure provides one having ordinary skill in the art with the information necessary to implement *any* embodiment of the claim, then that person is enabled to make and use the claimed invention.

The Examiner asserts that the specification does not provide enablement for accessing another game server via a wire-line. Regardless of whether or not this is the case, it is clear that the specification provides ample support for accessing a server via a wireless LAN. *See, e.g.*, page 4, lines 3–25. As such, one having ordinary skill in the art would certainly be able to implement accessing and using a second gaming server. Whether or not unclaimed features, such as access via wire-line, are supported by the specification is irrelevant.

The Examiner has further rejected the claims as lacking enablement with respect to providing the ability to transport the savable character from the first gaming server onto a second gaming server. This does not seem distinct from the argument the Examiner made with respect to claims 1 and 11 alone. As such, Applicants reaffirm the above arguments with respect to claims 3–7, 9, 12–13, and 15–19.

For at least the above reasons, it is respectfully asserted that the present disclosure provides sufficient information to enable one having ordinary skill in the art to implement and use all of claims 1, 3–7, 9, 11–13, and 15–19. Reconsideration of the rejection is earnestly solicited.

Claims 1, 3–7, 9, 11–13, and 15–20 stand rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter of the invention.

The Examiner first rejects claim 1, stating that the language “the game server” is vague

and indefinite for lacking an antecedent basis. However, this language does not appear in claim

1. The Examiner is presumably objecting to “the gaming server,” due to the recitation of “a *first* gaming server.” As such, claim 1 has been amended to consistently recite, “the first gaming server.”

The Examiner further rejects claim 1, stating that the “savable character” language is vague and indefinite, as it is not clear which savable character it refers to. In order to clarify this point, claim 1 has been amended to specify in line 11 that the *saved* character (i.e., the character saved in the prior “saving” step) is transported. It is believed that this amendment makes it clear what the state of the character is when it is being transported.

With regard to claim 9, the Examiner asserts first that “providing a second game server” is vague and indefinite because it is not clear whether it refers to the second game server of claim 1. In order to clarify this feature, claim 9 has been amended to recite the rejected element as a “wherein” clause, providing further definition for the second gaming server recited in claim 1.

Further with regard to claim 9, the Examiner asserts that “the transport medium” is vague and indefinite because it does not refer to any previous element. However, this language is not recited in claim 9. Instead, claim 9 recites, “the transportable medium,” which clearly refers to the “transportable storage medium” of claim 1. One having ordinary skill in the art will would readily understand this to be the case and would find claim 9 to be clear and definite with respect to “the transportable medium.”

The Examiner next rejects claim 11, stating that “the saved character” is vague and indefinite because it is not clear if it refers to “a saved character” or “the selected savable character.” However, the previous usage of “a saved character” is recited in describing a step of

providing the ability to save. It is only in the subsequent “saving” step that a character is actually saved. As such, one having ordinary skill in the art would recognize that “a saved character” refers to the “selected savable character” which was actually saved in the “saving step.” It is therefore respectfully asserted that claim 11 is clear and definite.

The Examiner next rejects claim 20, stating that “transportable from first gaming server to a second gaming server” is unclear with regard to whether the character is the “stored savable character” or the “saved character.” In order to clarify this point, claim 20 has been amended to change the verb “store” into “save.” This makes it clear that the device of claim 20 saves a savable gaming character, after which point it becomes a “saved” character.

Finally, the Examiner requests generally that the use of “selected savable character” and “saved character” be made consistent. However, selecting and saving are provided in two separate steps. Thus there may be a period of time in which a savable character has been selected, but not yet saved. As such, the “selected savable character” and the “saved character” language refer to distinct points in the manipulation of the character.

For at least the above reasons, it is believed that all of claims 1, 3–7, 9, 11–13, and 15–20 are clear and definite. Reconsideration of the rejection is earnestly solicited.

Claims 1, 4–7, 9, 11–13, and 15–20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2007/0105624 to Tyler (hereinafter “Tyler”) in view of U.S. Patent No. 6,716,102 to Whitten et al. (hereinafter “Whitten”) and further in view of U.S. Patent No. 6,951,516 to Eguchi et al. (hereinafter “Eguchi”).

Claim 1 as amended recites, *inter alia*, “providing at least one selectable gaming environment on the first gaming server.” Claims 11 and 20 recite analogous language. The

Examiner does not seem to note the distinction between a game and a gaming environment, and as such does not provide any specific citation against this language.

The present specification defines a gaming environment on page 4, lines 16–17, “The gaming environment(s) include, e.g., computer game settings without characters.” None of the cited art provides for such a gaming environment.

Addressing Eguchi first, it should be noted that the reference spends substantial time dealing with the generation of, transportation of, and interaction with, game-provided characters. *See, e.g.*, Eguchi, FIG. 17A. Although Eguchi uses the word “environment” somewhat regularly, it clearly does not fit within the definition provided within the present specification. Because Eguchi does not disclose or suggest a game setting *without* characters, Eguchi fails to disclose or suggest providing a gaming environment.

Tyler and Whitten fail to cure the deficiencies of Eguchi in this respect. Tyler is directed entirely toward a system for preventing cheating, and as such has no regard whatsoever for the particular kind of game setting that is to be used. Whitten, meanwhile, is directed solely toward displaying stored data in a game system. As such, Whitten similarly has no discussion of particular game settings.

As such, it is respectfully asserted that Tyler, Whitten, and/or Eguchi, taken alone or in any combination, fail to disclose or suggest providing a selectable gaming environment.

Claim 1 further recites, “providing the ability to enter the saved character for play in the selected gaming environment.” Following logic similar to that described above, if the cited art fails to disclose or suggest gaming environments at all, it must also fail to disclose or suggest entering a character for play in such a gaming environment. It is therefore respectfully asserted

that Tyler, Whitten, and/or Eguchi, taken alone or in combination, fail to disclose or suggest providing the ability to enter a saved character for play in a selected gaming environment.

For at least these reasons, it is believed that claims 1, 11, and 20 are in condition for allowance. Because claims 4–7, 9, 12–13, and 15–19 depend from claims 1 and 11 and include all of the elements of their parent claims, it is believed that these claims are also in condition for allowance. Reconsideration of the rejection is earnestly solicited.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tyler in view of Whitten and Eguchi and further in view of U.S. Patent No. 6,800,027 to Giobbi et al. (hereinafter “Giobbi”).


Claim 3 depends from claim 1 and includes all of its elements. Giobbi cannot cure the deficiencies Tyler, Whitten, and Eguchi described above. For example, Giobbi makes no mention of entering a character for play in any kind of setting, let alone a gaming environment. It is therefore respectfully asserted that Tyler, Whitten, Eguchi, and/or Giobbi, taken alone or in any combination, fail to disclose or suggest all of the elements of claim 3. As a result, it is believed that claim 3 is in condition for allowance. Reconsideration of the rejection is earnestly solicited.

In view of the foregoing amendments and remarks, it is respectfully submitted that the claim now pending in the application is in condition for allowance. Early and favorable reconsideration of the case is respectfully requested.

It is believed that no additional fees or charges are currently due. However, in the event that any additional fees or charges are required at this time in connection with the application, they may be charged to Applicant's Deposit Account No. 07-0832.

Respectfully submitted,

Date: 1-6-10

By: 
Jeffrey D. Hale
Reg. No. 40,012

THOMSON LICENSING LLC
Patent Operations
P.O. Box 5312
2 Independence Way
Princeton, NJ 08543-5312